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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,330	01/22/2001	Scott Thomas Molloy	14013-29US	9338

20575 7590 02/23/2007
MARGER JOHNSON & MCCOLLOM, P.C.
210 SW MORRISON STREET, SUITE 400
PORTLAND, OR 97204

EXAMINER

SAM, PHIRIN

ART UNIT	PAPER NUMBER
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2616

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/767,330

Applicant(s)

MOLLOY, SCOTT THOMAS

Examiner

Phirin Sam

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

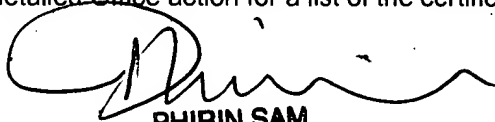
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



PHIRIN SAM
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 17-24 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2002/0075519 (hereinafter referred as “Konsella”).

Regarding amended claim 17 and claims 18-21, Konsella discloses a method for sending and receiving e-mail messages using a fax device (see Fig. 2b, element 12b) comprising:

- (a) receiving an e-mail message through a data communications network from an e-mail sender (see Fig. 2c, paragraph [0019]);
- (b) converting the e-mail message into a fax document (see Fig. 2c, paragraph [0024]);
- (c) retrieving a destination fax number independent of the e-mail message (see Figs. 4a and 4b, elements 40a and 40b, paragraphs [0025] and [0026]; wherein the user signs up for the E-service or personal switchboard service and the outgoing profile 40a or modified outgoing profile 40b stored in the service);
- (d) transmitting the fax document to a fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data-networking network (see Fig. 4a, element 62k, paragraph [0024]).

Regarding amended claim 21, Konsella discloses a computer readable medium having stored therein computer readable program code comprising instructions for performing the following steps:

- (a) receiving an e-mail message, from through a data communications network (see Fig. 2c, paragraph [0019]);
- (b) converting the e-mail message into a fax document (see Fig. 2c, paragraph [0024]);
- (c) retrieving a destination fax number independent of the e-mail message (see Figs. 4a and 4b, elements 40a and 40b, paragraphs [0025] and [0026]; wherein the user signs up for the E-service or personal switchboard service and the outgoing profile 40a or modified outgoing profile 40b stored in the service);
- (d) transmitting the fax document to a fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Fig. 4a, element 62k, paragraph [0024]).

Regarding amended claim 22 and claims 23-24, Konsella discloses a device comprising:

- (a) means for receiving an e-mail message, from through a data communications network (see Fig. 2c, paragraph [0019]);
- (b) means for converting the e-mail message into a fax document (see Fig. 2c, paragraph [0024]);
- (c) means for retrieving a destination fax number independent of the e-mail message (see Figs. 4a and 4b, elements 40a and 40b, paragraphs [0025] and [0026]; wherein the user signs up

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for the E-service or personal switchboard service and the outgoing profile 40a or modified outgoing profile 40b stored in the service);

(d) means for transmitting the fax document to a fax recipient thereby enabling the fax recipient to receive e-mail messages without access to the data networking network (see Fig. 4a, element 62k, paragraph [0024]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0075519 (hereinafter referred as "Konsella") in view of US Patent 6,424,426 (hereinafter referred as "Henry").

Regarding amended claim 1 and claims 10-16, Konsella discloses An Advanced Research Projects Agency (ARPA) Internet Network Access/Service Provider device comprising:

(a) a storage device for storing an e-mail message received from an e-mail sender for transmission to a fax recipient through a packet switching network, the stored e-mail message to be converted to a fax document for transmission thereof to the fax recipient having access to a fax device (see Figs. 1, 2c, 4a, and 4b, abstract, paragraphs [0014], [0015], [0016], [0019], [0024], [0026]);

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(c) at least one device for transmitting the fax document to the fax recipient through a public switching network, wherein a fax number designating the fax recipient is obtained independently of the e-mail (see Fig. 2c, elements 24, paragraph [0019],

Konsella does not disclose a fax gateway and a fax modem. However, Henry discloses the fax gateway and the fax modem (see Figs. 2 and 5, elements 20, 22, 64, and 66, col. 5, lines 28-32). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine fax modem and fax gateway teaching by Henry with Konsella. The motivation for doing so would have been to provide the ability to send, to convert email to fax and fax to email read on abstract. Therefore, it would have been obvious to combine Henry and Konsella to obtain the invention as specified in the claims 1 and 10-16.

Regarding claims 2-6, Konsella discloses the storage device further can store a fax telephone number associated with the fax device of the fax recipient, the fax telephone number to be used to establish a call for the transmission of the fax document (see Figs. 4b and 4c, paragraphs [0025]-[0028]).

Regarding claims 7-9, Konsella discloses he ARPA-Internet Network Access/Service Provider device assigns an e-mail address to the fax recipient, the e-mail address being identified by a fax telephone number identifying the fax device and wherein the fax cover page for further including a destination field extracted from the fax recipient e-mail address (see Figs. 4b and 4c, paragraphs [0025]-[0028]).

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phirin Sam whose telephone number is (571) 272-3082. The examiner can normally be reached on a compress schedule, from 8:00-5:30, first Wed off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571) 272 - 3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully submitted,

Date: December 13, 2006

A handwritten signature in black ink, appearing to read 'Phirin Sam', written over a horizontal line.

**PHIRIN SAM
PRIMARY EXAMINER**